

Remarks

In the Office action, claims 1-8, 10, and 11 were rejected as being unpatentable over a number of patents.

By way of the foregoing amendment, claims 1 and 7 have been amended. Claim 9 has been cancelled without prejudice in a prior Office action. Accordingly, claims 1-8, 10, and 11 are pending and at issue in the above identified patent application. Of the claims at issue, claims 1 and 7 are independent. In view of the foregoing amendments and the following remarks, reconsideration of the application is respectfully requested.

The Rejections Under 35 U.S.C. § 103

Claim 1 was rejected as being unpatentable over U.S. Patent No. 6,029,045 (“Picco”) in view of U.S. Patent Application No. 2003/0226141 (“Krasnow”). Claim 7 was rejected as being unpatentable over Picco in view of U.S. Patent Application No. 2004/0078812 (“Calvert”). Applicants respectfully submit that claims 1 and 7, and claims dependent therefrom, are allowable over these patents, and patent applications, for the reasons set forth below.

Claim 1

Independent claim 1 recites, *inter alia*, a method of displaying an advertisement using metadata comprising displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program, and displaying the advertisement *in response to* the matching. As discussed below, the applicants respectfully submit that neither Picco nor Krasnow discloses displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program, and displaying the advertisement *in response to* the matching. As a result, any combination of Picco and Krasnow necessarily fails to disclose displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program, and displaying the advertisement in response to the matching.

To establish a *prima facie* case of obviousness, the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements. See *In re Oetiker*, 24 USPQ. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 USPQ. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143.

While Picco describes a system for communicating a programming data stream to a set-top box and a data stream containing pieces of local content data that are going to be inserted into a local content space in the programming data stream, Picco does not disclose displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program. Page 6 of the Office action appears to contend that the program specific information (PSI) taught by Picco corresponds to the second metadata recited in claim 1. On the contrary, the PSI of Picco is described as including a program access table (PAT) and a program mapping table (PMT) that is multiplexed into a data stream along with local content. *See 8:56-67 and Figure 5*. Picco further describes that the PAT indicates to a receiver a proper location for signals and the PMT indicates an association of program identifiers with corresponding television stations. *See 5:27-49 and Figure 2*. The program identifiers merely contain a television signal that is further composed of both programming data streams and blank spots within that data stream reserved for local content. *See 5:49-54 and Figure 2*. In particular, while such blank spots are intended for local content (e.g., commercials), they are void of information, thus cannot be considered to contain metadata, much less second metadata describing subject matter of the displayed television program. Rather, Picco generally describes the PSI, PAT, PMT, and the program identifiers as participating in a satellite communication protocol used to define time slots for programming information, advertising information, and to tell a receiver which program identifiers are associated with particular stations. However, neither the PSI, PAT, PMT, nor the program identifiers include second metadata, the second metadata describing *subject matter* of the displayed television program. As such, Picco fails to teach or suggest displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program.

Moreover, Picco fails to disclose displaying the advertisement in a banner form *in response to* the matching. While page 3 of the Office action contends that the claimed limitation lacks any temporal restrictions, thereby allegedly rendering moot the applicants' prior argument in the response to the Office action dated February 9, 2005, the applicants respectfully maintain that the language "in response to" requires such a temporal limitation. As an illustration, the language "displaying the advertisement *in response to* the matching" necessarily requires that matching occur *prior* to the display. Additionally, despite Picco teaching that command and control data may be downloaded in real-time with the programming data streams (*See 9:61 through 10:20*), such determination of where to insert the stored local content is merely a result of a set-top box following instructions of the control data, rather than displaying the advertisement *in response to* the matching, wherein the matching comprises (as recited by claim 1) matching the second metadata of the displayed television program with the first metadata associated with the advertisement. Consequently, unlike the command and control data of Picco, the claimed limitation matches the second metadata of the displayed television program with the first metadata associated with the advertisement, and display[s] the advertisement *in response to* the matching. As such, independent claim 1 recites a temporal limitation, and Picco necessarily fails any teaching of matching the second metadata with the first metadata, and displaying the advertisement in a banner form *in response to* the matching.

While Krasnow discloses advertisements in a banner and advertisements including metadata, Krasnow fails to disclose displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program. As discussed in the response to the Office action dated February 9, 2005, Krasnow merely describes a system, device and method for maintaining advertisements that a user has already seen, and allowing users to view those advertisements again. Krasnow's system 100 includes stored content, such as movies, television programs, and commercials. A content distribution system 106 distributes such content to client devices 108 (also referred-to as set top boxes). *See generally ¶'s 0020, 0024 and 0025.* The system 100 also includes stored on-demand content 134 to stream movies and other content to a corresponding client device 108. The client devices 108 receive all content, including advertisements. Krasnow further describes that a network operator can communicate

metadata about advertisements that will be broadcast directly to the advertisement data store 302. The data store 302 stores displayed advertisements so that a viewer can, via an advertisement component 338 in the client device 108, select an advertisement to categorize, store, delete, and later find advertisements previously seen. *See generally ¶'s 0047-0050 and 0066.* Consequently, and similarly to Picco, Krasnow does not disclose displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program. While the Examiner identifies the Krasnow reference to allegedly cure the missing banner limitation lacking in the Picco reference, the Krasnow reference also fails to teach or suggest displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program.

Krasnow also fails to disclose displaying the advertisement in a banner form *in response to* the matching. As discussed above, the recited limitation “matching” of claim 1 includes matching the second metadata of the displayed television program with the first metadata associated with the advertisement, wherein the second metadata describe[es] subject matter of the displayed television program. Krasnow, on the other hand, teaches that a network operator can communicate metadata about advertisements that will be broadcast directly to the advertisement data store (*See ¶0037*) and that an advertisement component recognizes advertisement content that is processed for display as a banner advertisement (*See ¶0047*). Further, Krasnow merely displays an advertisement, or permits a viewer an option to select which advertisements are to be viewed or stored for later viewing. However, Krasnow fails to teach or suggest displaying the advertisement in a banner form *in response to* the matching, as recited in claim 1.

As neither Picco nor Krasnow disclose (1) displaying a television program, the television program comprising second metadata, the second metadata describing subject matter of the displayed television program, and (2) displaying the advertisement in a banner form *in response to* the matching, it follows that neither Picco nor Krasnow, alone or in combination, can render claim 1 as obvious. Dependent claims 2-6 depend from independent claim 1 and are allowable for at least the reasons discussed above in association with claim 1. Therefore, the applicants respectfully request allowance of claims 1-6.